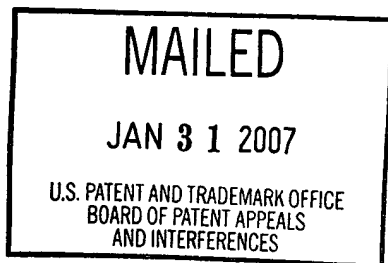


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUHIRO FUJII



Appeal No. 2006-0985
Application No. 09/766,696

ON BRIEF

Before PATE, OWENS and BAHR, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-16, 66, 67, 69 and 77-82. Claims 19-65 and 74-76 stand withdrawn from consideration. Claims 68 and 70-73 have been previously allowed. Claims 17 and 18 were allowed by the examiner in the answer at page 2. These are all the claims in the application.

The claimed invention is a bracket for mounting a separate, self-contained motor that controls the bicycle transmission to a bicycle frame. The bracket has a

base for reception of the motor and first and second bracket supports for attachment to the bicycle chain stay.

Claim 82, reproduced below, is further illustrative of the claimed subject matter.

82. A bracket apparatus for mounting a separate self-contained motor that controls a bicycle transmission to a bicycle frame, wherein the frame has a bottom bracket shell, a seat tube extending upwardly relative to the bottom bracket shell, a first chain stay extending rearwardly relative to the seat tube and a first seat stay extending rearwardly relative to the seat tube above the first chain stay, wherein the apparatus comprises:

a bracket base dimensioned for supporting the motor at least partially above the first chain stay and at least partially below the first seat stay such that the motor can be removed as a unit from the bracket base;

wherein the bracket base has an upper surface that supports the motor as to receive a vertically downwardly directed force component from a portion of the motor mounted above it;

a first bracket support for coupling the bracket base to at least one of the first chain stay and the first seat stay; and

a second bracket support for coupling the bracket base to at least one of the first chain stay, the seat tube, and the bottom bracket shell.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Chappell	4,599,079	Jul. 8, 1986
Ethington	5,681,234	Oct. 28, 1997

Claims 1-16, 66, 67, 69 and 77-82 stand rejected under 35 U.S.C. § 103 as unpatentable over Ethington in view of Chappell.

ISSUES

Appellant advances two contentions with respect to the examiner's rejection. Appellant contends that it would not have been obvious to position Ethington's power unit 50 on a chain stay. Appellant further contends that neither reference teaches a control device which can be removed as a unit from the claimed bracket. Accordingly, the sole issue presented in this appeal is whether the examiner has established, by a preponderance of evidence, the prima facie obviousness of claims 1-16, 66, 67, 69 and 77-82.

FINDINGS OF FACT

Ethington discloses a control device for a bicycle transmission. The control device 50 is mounted with clamp bands 58 to the down tube of the bicycle frame. Figure 5 shows the power unit in detail. The power unit has two reversible rotary electric servo motors 112 which operate lead screws to reciprocate cables 66 and 68. A battery compartment 51 is removably mounted on the power unit 50.

Chappell also describes an automatic shifter for a derailleur which is operated by the conventional cables normally found on a bicycle. The automatic shifter is connected to a bicycle chain stay 38 by means of a bent connecting finger 46.

Ethington differs from the claimed subject matter in that it does not show a separate bracket and a removable control device, and the control device of Ethington is installed on the drop tube rather than on the chain stay. Chappell differs from the claimed subject matter in that Chappell does not disclose a removable control device nor does it show a horizontal bracket base. However Chappell is located on a bicycle chain stay as the claims require.

Principles of Law

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art. In re Kahn, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006) citing 35 U.S.C. § 103(a) (2000); Graham v. John Deere Co., 383 U.S. 1, 13-14, 148 USPQ 459, 467 (1966). The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact. Id. (citing In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)).

In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in Graham v. John Deere Co. Kahn at 985, 78 USPQ2d at 1335. The Board determines “the scope and content of the prior art,” ascertains “the differences between the prior art and the claims at issue,” and resolves “the level of ordinary skill in the pertinent art.” Id. (citing Dann v. Johnston, 425 U.S. 219, 226, 189 USPQ 257, 261 (1976)) (quoting Graham, 383 U.S. at 17, 148 USPQ at 467). Against this background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention. Id. (Citing Graham, 383 U.S. at 17, 148 USPQ 467). In making this determination, the Board can assess evidence related to secondary indicia of non-obviousness like “commercial success, long felt but unresolved needs, failure of others, etc.” Id., 383 at 17-18, 148 USPQ at 1335; accord In re Rouffett, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). We have explained that to reject claims in

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an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness. *Id.* (citing Rouffett, 149 F.3d at 1355, 47 USPQ2d at 1456).

Analysis

The examiner is reading the case of power unit 50 including the upper flat surface of the bottom wall as the bracket. Appellant argues that there is no teaching of making a control device removable from the bracket as a unit as required in the independent claims. The examiner has stated that the ability of the motor to be removed is a function of the motor design and not of the support. Be that as it may, it is still a claimed feature of the invention on appeal and all claim features must be present or taught by the prior art to establish the prima facie obviousness of the claims on appeal. Inasmuch as we agree with the appellant that neither reference teaches a control device that can be removed as a unit from the bracket base, we are constrained to reverse the examiner's rejection on appeal.

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Conclusion of Law

For the foregoing reasons, the examiner has not established the prima facie obviousness of all claims on appeal.

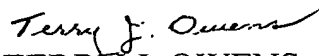
ORDER

The rejection of all claims on appeal is reversed.

REVERSED



WILLIAM F. PATE, III
Administrative Patent Judge



TERRY J. OWENS
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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Deland Law Office
P.O. Box 69
Klamath River, CA 97603-0069

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